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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/010,801	01/22/1998	MARK HAMBURG	07844/235001	9111
21876	7590	06/13/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/010,801	Applicant(s) MARK HAMBURG	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-25, 27-37 and 39-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-7, 9-25, 27-37, and 39-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-7, 9-25, 27-37, and 39-47 are pending. Claims 1, 9, 16-18, 22, 37, 39-43 have been amended in this communication filed 02/28/05 entered as Supplemental Response.
2. The Response After Non-Final Action filed 02/24/05 has been entered.
3. The 35 USC 112 first and second paragraphs for claims 1, 9, 16-18, 22, 37, and 39-43 still remains as set forth here below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 9, 16-18, 22, 37, and 39-43 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. What the cause and effect of the state change and what state is being captured are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is unclear from Applicants' disclosure what the captured state is, what caused the captured state, and what the effect is of the captured state. Applicants' do not disclose that the state is an undo history list or a redo history list of operations on the document. It appears to be virtually impossible to achieve what Applicants' are attempting to claim in the claim language. What operation is being performed to capture what state of the document?

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1, 9, 16-18, 22, 37, and 39-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear and vague from the claim language what Applicants' are really attempting to claim. For example, "maintaining in a memory a state history of a document". What is meant by the state history of this document? Claim 1, line 3, reads "... an interesting operation being an operation by the application that changes the state of the document in response to a user command, automatically capturing the state of the document in response to the user command, automatically capturing the state of the document as it exists after the operation" ... the captured state being complete in itself in the sense that earlier document states in the state history of the document can be deleted without adverse effect" is vague and unclear as written. The Examiner is unsure what Applicants' are trying to say or to claim. Claims 9, 16-18, 22, 37, and 39-43 have a similar problem. Claim 1, lines 4-9 are confusing as written. Claim 9, lines 6-9; claim 17, lines 3-6; claim 18, lines 3-6; claim 22, lines 3-5; claim 37, lines 6-12; claim 39, lines 5-8 on page 11; claim 42, lines 3-6; and claim 43, lines 4-6 have a similar problem.

Election/Restrictions

8. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 37, and 45-47, drawn to performing the operations on documents with states and capturing the states, classified in class 715, subclass 530.
 - II. Claims 9-15 and 39, drawn to a user editing the document having a document state, adding an entry to a history list and selecting an item in the history list, classified in class 715, subclass 744.
 - III. Claims 16-21 and 40- 42, drawn to creating and editing the document, classified in class 715, subclass 513.
 - IV. Claims 22-25, 27-36, 43, and 44 drawn to creating and modifying the document, classified in class 358, subclass 1.15.
9. Inventions Group I, Group II, Group III, and Group IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). The inventions are distinct, each from the other because of the following reasons: In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I has separate utility such as performing the operation and capturing the states of the documents. The subcombination Groups II, III and IV have separate utility such as creating, editing, and modifying the document. Group I the combination can perform the operations and capture the states of the documents of the subcombination in Groups II, III and IV. Group I can be used in other document processing applications, Group II can

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be used in the editing of documents and other forms, Group III can be used in creating and editing a document in other areas such in pre-press printing, and Group IV can be used to create and modify a document in other areas of written communication.

10. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III and IV and the search for Group II is not required for Groups I, III, and IV, the search for Group III is not required for Groups I, II, and IV, and the search for Group IV is not required for Groups I, II, and III restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Response to Arguments

13. Applicants' arguments filed 02/28/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue in the 07/ 17/04 response: the Applicants' respectfully submit that, as amended, claims 17, 18, 41, and 42 are not indefinite for

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failing to particularly point out and distinctly claim the subject matter which applicants' regard as the invention and that the Examiner's rejection of these claims is thereby overcome. Response: Claims 17, 18, 41, and 42 have claim limitations that are confusing as written and addressed above in the 35 USC 112 second paragraph rejection.

Issue no. 2: Applicants' argue in the 02/28/05 Supplemental Response: The Examiner stated that "[W]hat the cause and effect of the state change and what the state is that is being captured are critical or essential to the practice of the invention, but [] not enabled by the disclosure. It is unclear from Applicants' disclosure what the captured state is, what caused the captured state, and the effect of the captured state" and the Applicants' respectfully disagree that such rejection is proper here. Response: The Applicants' appear to have left steps out of the claims and not claimed what is considered to be the essential steps addressing these issues. Applicants' are respectfully requested to point out in their disclosure "what the captured state is, what caused the captured state, and the effect of the captured state" these limitations in Applicants' disclosure and to clarify the limitations in the claim language.

Comments: A Restriction has been found in the application and addressed above in the section entitled "Election/Restriction Requirement". As Applicants' see from the Restriction the claims are classed in different classes and subclasses because of their claim limitations in the independent claims. Claims 1-7, 37, and 45-47 are directed more toward performing the operations on documents with states and capturing the states; claims 9-15 and 39 are directed more toward the editing of the document;

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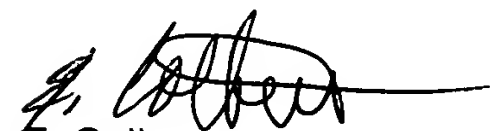
claims 16-21 and 40-42 are directed more toward the editing plus the creation of the document; and claims 22-25, 27-36, 43, and 44 are directed more toward not only the creation of the document but the modification of the document and thus restriction has been considered proper for these reasons.

Inquiries

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


E. Colbert
June 9, 2005